

Appn. Number 09/625,017      (Levine, David)      GAU 3621      Amnt. B

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## **REMARKS**

### **Claim Changes**

As agreed in the 9/3/03 interview, the amendments to Claims 1 and 20 overcome the rejections in the 7/8/03 Office Action, because neither the Logan nor the Fleming reference discloses or suggests that the report of a user's prior use of materials is not a complete accounting of the prior use, but rather a *sample* of the prior use. In addition, neither the Logan nor the Fleming reference discloses or suggests that the convolution of an updated metric of use is a *statistical* convolution, relating to the fact that the report is a sample of the prior use, and not a complete accounting.

Moreover, since independent claims 1 and 20 now define patentably over the prior art, the dependent claims in the application also define patentably.

It should be noted that other minor changes were made to Claims 1 and 20, as well as to Claims 8, 9, 10, and 14, to correct punctuation errors. These minor changes have no effect on the scope of the claims.

### **Advisory Action**

Applicant respectfully requests that an Advisory Action not be issued, for the following reasons:

**I.      The Minor Amendment Made to Claims 1 and 20 Should Not Raise a New Issue Requiring More Than Nominal Reconsideration or Search.**

37 CFR 1.104 and MPEP 707 both state:

"On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention."

Under 37 CFR 1.104 and MPEP 707, the initial search should be based on a thorough study of the application and its subject matter, and the amended claims certainly do not go outside the scope of the original application or its subject matter. Thus, no more than a nominal re-search should need to be made.

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**II. Examiner and Applicant Have Not Reached a Clear Issue, as Recommended by MPEP 706.07.**

MPEP 706.07 states:

"A clear issue between applicant and examiner should be developed, if possible, before appeal."

"The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

In the present application, a clear issue has not been reached. Instead, Examiner and Applicant agree that the amendments contained herein overcome the rejections in the 7/8/03 Office Action. Therefore, no clear issue has been reached between Examiner and Applicant.

**Showing Under 37 CFR 1.116**

If, notwithstanding the above, Examiner issues an Advisory Action declining to enter the amendment, Applicant requests that the amendment be entered for purposes of appeal, because it places the application in better form for appeal by materially reducing or simplifying the appeal issues. *See 37 CFR 1.116*: "Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered."

If the application is appealed, the appeal will be based on the 7/8/03 Final Office Action, and only the 7/8/03 Final Office Action. That Final Action rejects Claims 1 and 20, the independent claims in the application, as being anticipated under 35 USC 102 by the Logan reference. It is clear from the 9/3/03 interview summary that this amendment overcomes the 102 rejections using the Logan reference. Thus, it is also clear that entering the amendment will reduce the issues in the appeal, because the 102 rejections using Logan will no longer be an issue.

This amendment was not earlier presented because based on the 2/7/03 Office Action, Applicant had a good faith belief that his claims already defined over the Logan and Fleming references, and presented a comprehensive response to the Office Action stating so. Examiner's further argument and guidance in the 7/8/03 Office Action persuaded Applicant that minor amendments were necessary to overcome Logan and Fleming, and Applicant immediately and proactively presented those amendments in the 9/3/03 interview. Agreement was then reached that the amendments overcame the Office Action rejections.

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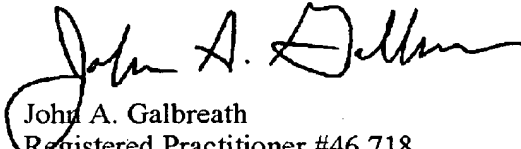
**Certified Copy of Foreign Priority Document**

A certified copy of the foreign priority document was ordered from the Israeli Patent Office after Examiner requested such a copy in the 2/7/2003 Office Action. However, the Israeli Patent Office had misplaced the application file, and could not provide a certified copy until just recently. The certified copy has now been sent to Applicant's agents in Israel, and will be forwarded to Examiner as soon as possible.

**CONCLUSION**

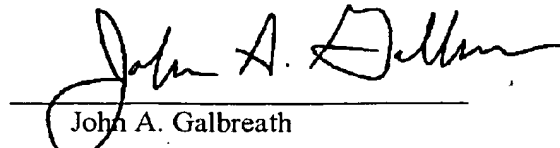
For all of the above reasons, Applicant submits that the claims are now in proper form, and that the claims all define patentably over the prior art. Therefore Applicant submits that this application is now in condition for allowance, which action they respectfully solicit.

Very respectfully,

  
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**Certificate of Fax Transmission:** I certify that on the date below, this document and referenced attachments, if any, was faxed to the U.S. Patent Office at 703-872-9327.

8 September 2003

  
John A. Galbreath**OFFICIAL**